



APPENDIX.

Trade-Mark Laws, Title 15, United States Code.

§ 96. Evidence of ownership; infringement, and damages therefor.

The registration of a trade-mark under the provisions of this subchapter shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs (Feb. 20, 1905, ch. 592, § 16, 33 Stat. 728).

§ 102. Suits involving interfering registered trade-marks.

Whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of

equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation (Feb. 20, 1905, ch. 592, § 22, 33 Stat. 729).

The Paris Convention of 1883 for the Protection of Industrial Property, Revised at Brussels 1900, at Washington 1911, at the Hague 1925, and at London 1934.

[The original and revised versions of the Convention are to be found in Malloy; *Treaties, Conventions Between United States and Other Powers* (1910, Vol. 2, pp. 1935, 1943, 1945; Vol. 3, p. 2953; Vol. 4, pp. 4945, 5516.

In Ladas; *International Protection of Trade Marks* (1929), p. 6, it is stated that the member countries of this Union are now thirty-eight, including the United States, Great Britain, Canada and Mexico. The excerpts printed below are copied from Derenberg; *Trade Mark Protection and Unfair Trading* (1936), pp. 1035-1050.]

ARTICLE 1.

1. The countries to which the present Convention applies constitute themselves into a Union for the protection of industrial property.

2. The scope of the protection of industrial property includes patents, utility models, industrial designs and models, trade-marks, commercial names and indications of origin or appellations of origin, as well as the repression of unfair competition.

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ARTICLE 2.

1. Nationals of each of the countries of the Union shall, in all other countries of the Union, as regards the protection of industrial property, enjoy the advantages that

their respective laws now grant, or may hereafter grant, to their own nationals, without any prejudice to the rights specially provided for by the present Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights provided they observe the conditions and formalities imposed upon subjects or citizens.

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ARTICLE 10. Bis

1. The countries of the Union are bound to assure to nationals of countries of the Union an effective protection against unfair competition.

2. Every act of competition contrary to honest practice in industrial or commercial matters constitutes an act of unfair competition.

3. The following particularly are to be forbidden:

(1) All acts whatsoever of a nature to create confusion by no matter what means with the establishment, the goods, or the services of the competitor.

(2) False allegations in the course of trade of a nature to discredit the establishment, the goods or the services of a competitor.

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ARTICLE 12.

1. Each of the countries of the Union agrees to establish a special Government service for industrial property, and a central office for communication to the public of patents, utility models, industrial designs or models and trade marks.

2. This service shall publish an official periodical paper. It shall publish regularly:

(a) The names of the owners of the patents granted with a short designation of the patented inventions;

(b) Reproduction of the marks which have been registered.

**G. H. McCann et al., Appellant, v. G. W. Anthony,
Respondent.**

St. Louis Court of Appeals, February 23, 1886.
(21 Missouri Appeal Reports 83.)

Appealed from the Greene County Circuit Court, W. F.
Geiger, Judge.

Reversed and remanded with directions.

Bakewell & Bakewell, for the appellants.

Francis H. Shepard, for the respondent.

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THOMPSON, J., delivered the opinion of the court.

This is a suit in equity to enjoin a colorable imitation of a label, by which the plaintiffs have long marked an article of smoking tobacco of their manufacture, called "Old Coon Smoking Tobacco," which has acquired a valuable reputation in the market. This label is in form, size and color substantially as follows:

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The plaintiffs have used this label continuously since the year 1874, and have built up a large trade in this brand of tobacco. Their business has always been carried on at Springfield, Missouri. The defendant has also been engaged in manufacturing smoking tobacco at Springfield, Missouri, for several years past, and has for several years manufactured a brand of smoking tobacco, called "Old Bachelor Smoking Tobacco." In the year 1883, the plaintiffs began putting their "Old Coon Smoking Tobacco" in cloth bags, retaining the above label, which they had previously used on the paper bags, in which they had been accustomed to put up the same tobacco. Soon afterwards, namely, in the fall of 1883, the defendant began putting up his "Old Bachelor Smoking Tobacco" in cloth bags of the same size, at the same time changing his label, which previously had borne no colorable resemblance to the above label of the plaintiffs, to a label of the form, size, and color, substantially as follows, with the exception of the words "Not Old Coon":

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As soon as the plaintiffs discovered that the defendant was putting up his tobacco with this label, they took the advice of counsel, and, under their instructions, a letter was written by their attorney to the defendant on the twenty-ninth of December, 1883, notifying him that his label deceived the public. The defendant replied that if that was so he would make some change in his label so that the public would not be deceived; and accordingly he made a change by printing on his label in large black letters the words "Not Old Coon," as above shown. The defendant sent one of these labels to the plaintiffs' attorney, who replied that the change did not amount to anything, and afterwards commenced this action. Two witnesses for the plaintiffs gave evidence to the effect that they had been deceived by the defendant's label into a supposition that the tobacco was the plaintiff's tobacco known as "Old Coon." On the other hand, the defendant introduced several witnesses, residents of Springfield, who testified under objection, after being shown these two labels, that they could not be deceived into taking one for the other, and that, in

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their opinion, no one would be deceived into purchasing one for the other at a different time or place.

We do not think it necessary to rule upon the question of the propriety of admitting this last testimony because the counsel for both parties were so candid as to state on the argument, what seems very obvious to us, that the whole case must be decided upon a comparison of the two labels, there being no conflict in the testimony. We may, also, say, at this point, that, in our view, that portion of the argument, advanced in favor of the defendant which

presses upon our attention a consideration of the presumptions which obtain support of the judgment of the circuit court, and of the consideration to which the finding of that court is entitled, in a cause in equity, is entirely misapplied here. In a suit in equity where the facts are in dispute an appellate court will, according to the settled practice in this state, defer very considerably to the finding of the court below. Nor is it doubted that, where the question for decision is merely a question of law, the conclusions of the learned judges of the circuit court are entitled to respectful and considerate attention at the hands of the appellate courts; but, nevertheless, in such cases, the appellate courts are bound to give judgment according to their views of the law. Here, the facts being undisputed, the sole question is, what conclusion of law is to be applied to the facts; and, deferring very considerably to the opinion of the learned judge who decided this case, we nevertheless think that the plaintiffs are entitled to the substantial relief prayed for. We have had several cases of this general nature before us; the principles upon which they are to be determined are pretty well settled and understood; and there is no very serious difference as to those principles between the counsel of the opposing parties and the court. The governing principle is that one manufacturer shall not be allowed to impose his goods upon the public as the goods of another manufacturer and so derive a profit from the reputation of that other. It is not necessary

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that the trade-mark, trade-name, sign, label, or other device which is employed by one merchant for that purpose shall be an exact imitation or counterfeit of the trade-mark, trade-name, sign, label, or other device employed by the other manufacturer. Nor is it required that the imitation be so close as to

deceive cautious and prudent persons; it is sufficient that it be so close as to deceive the incautious and unwary, and thereby work substantial injury to the other manufacturer. Nor is it necessary to prove that actual fraud was intended by the manufacturer employing the simulated trade-mark, trade-name, sign, label, or other device, in order to entitle the other manufacturer to relief in equity or to an action for damages at law. Here, as in most other civil actions, the law does not attempt to penetrate the secret motives or intent with which the act is done, but contents itself with the conclusion that the party intended the natural and probable consequences of the act, and gives its judgment accordingly. These principles are embodied and discussed with more or less distinctness in the following cases: *Filley v. Fassett*, 44 Mo. 168; *Conrad v. Joseph Uhrig Brewing Co.*, 8 Mo. App. 277; *Gambel v. Stephenson*, 10 Mo. App. 581; *Sanders v. Jacobs*, 20 Mo. App. 96.

Applying these principles to the case before us, it is perceived that the defendant's label resembles the plaintiffs' in three distinct particulars, of form, size, and color.

1. In *form* it is an oblong, like that of the plaintiffs. It, also, has an oval vignette in the center, and the plaintiffs' has a circular vignette in the upper center. It, also, has the words, designating the number of the factory, printed in the left hand margin on a white field, the letters reading from the top downwards, as in the plaintiffs'. It, also, has the notice required by the internal revenue law, printed on a corresponding white field, on the right hand margin, the letters reading from the bottom upwards, as in the plaintiffs'.
- 2 In *size* it is the same as the plaintiffs'.
3. In *color* the whole

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background is red, the most conspicuous of the colors, as in the plaintiffs'. Leaving out of view the fact that the defendant began putting up his

tobacco in cloth bags soon after the plaintiffs began putting up their tobacco in the same kind of packages, which the defendant explains by stating that smoking tobacco could no longer be sold in paper packages, we find that there are no less than six distinct points of resemblance between the two labels. 1. The general form. 2. The oval vignette. 3. The lettering on the white field on the left hand side. 4. The lettering on the white field on the right hand side. 5. The size. 6. The general color. In view of these points of resemblance it is scarcely probable that when the defendant designed this label he did not have in his mind the distinct purpose of making as close an imitation of the plaintiffs' label as he felt it safe to do. Now, as he admits in his testimony that since he adopted this label his trade has increased, and does not state any facts which lead to the inference that this increase has been due to any other cause than his success in making this colorable imitation of the plaintiffs' label, we think it a fair conclusion that he had the purpose in view of banking, so to speak, on the plaintiffs' reputation and that he has measurably succeeded in so doing. We do not think that the printing of the words "Not Old Coon," upon the defendant's label affords a sufficient reparation of the wrong. The defendant can easily repair the wrong without much expense to himself and without destroying the plate upon which his label is printed, by adopting a color upon the background distinctly different from red, or by making a new plate and changing the other distinctive characteristics of form and size, above pointed out.

The judgment of the circuit court will be reversed and the cause remanded, with directions to enter a decree perpetually enjoining the defendant, his agents, and servants, from manufacturing, selling, or offering for sale, any smoking tobacco manufactured by him, or by any

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other than the plaintiffs, having affixed upon the packages or bags containing the same, the label described in the petition as used by the plaintiffs, or any other label having such characteristic features as to constitute a colorable resemblance of the plaintiffs' label. It is so ordered. All the judges concur.

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